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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,987

10/11/2006

Jouni Korhonen

5420-10PUS

3403

27799

7590

07/21/2009

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551 FIFTH AVENUE

SUITE 1210

NEW YORK, NY 10176

EXAMINER

PHAM, TITO Q

ART UNIT

PAPER NUMBER

2419

MAIL DATE

DELIVERY MODE

07/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,987	<b>Applicant(s)</b> KORHONEN ET AL.	
	<b>Examiner</b> TITO PHAM	<b>Art Unit</b> 2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/25/2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities: missing Background of the Invention, Summary of the Invention, and Detailed Description of the Invention.

Appropriate correction is required.

### ***Drawings***

3. The drawings are objected to because lack of text labeling in figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

6. Claim 10 lines 3-6 cites "name server...arranged to verify...the transmission data of the desired network element and to return said transmission data to the querying party." The specification does not disclose a name server "verify" a transmission data. Rather the specification teaches a name server looks up a table/database and returns a requested network address to a querying party. Without further teaching, one skilled in the art does not know how to make and use the claimed invention without undue experimentation.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

10. Claim 1 line 3 discloses "data networks are different to each others." It is unclear whether the transmitting and receiving networks utilize different network protocol or the transmitting and receiving networks are two separate networks.

11. Regarding claim 1 line 1, it is unclear what is considered "a communication."

12. Regarding claim 1, it is unclear how a network can transmit a communication.

13. Claim 1 recites the limitation "the transmitting network element" in line 4. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 1 recites the limitation "this network address" in 5. There is insufficient antecedent basis for this limitation in the claim.

15. Regarding claim 1 lines 6-7, it is unclear the meaning of "querying... from the private name server." Doesn't it mean "querying ...to?"

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16. Regarding claim 1, Examiner does not understand the claim invention. Applicant should rewrite the claim language so that one skilled in the art can understand the invention as claimed.

17. Regarding claim 2, Applicant should rewrite the claim as well.

18. Claim 3 recites the limitation "the transmitting data transmission network" in 3. There is insufficient antecedent basis for this limitation in the claim. Independent claim 1 discloses a "data transmission network" not "transmitting data transmission network."

19. Claim 3 recites the limitation "the local name server" in 2. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 3 recites the limitation "the local domain name server" in line 3. There is insufficient antecedent basis for this limitation in the claim.

21. Regarding claim 4, it is unclear the meaning of "the network address data."

22. Claim 4 recites the limitation "the private name servers of other" in 3. There is insufficient antecedent basis for this limitation in the claim.

23. Claim 5 line 3 discloses "data networks are different to each others." It is unclear whether the difference pertains to network protocol or the transmitting and receiving networks are two separate networks.

24. Regarding claim 5, it is unclear the meaning of "means of"

25. Claim 5 recites the limitation "the network address" in 9. There is insufficient antecedent basis for this limitation in the claim.

26. Regarding claim 5 lines 5 and 10, it is unclear why there is a transmitting element in a receiving network. Isn't it supposed to be receiving element?

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27. Regarding claim 5, Examiner does not understand the claim invention. Applicant should rewrite the claim language so that one skilled in the art can understand the invention as claimed.

28. Regarding claim 6 line 3, isn't it supposed to be "query to" instead of "query from?"

29. Claim 7 recites the limitation "the private domain name server" in line 2. There is insufficient antecedent basis for this limitation in the claim.

30. Regarding claim 9, isn't it the "transmitting network element" supposed to be the "receiving network element?"

31. Claim 10 recites the limitation "the query" in line 3 and "the desired network element" in line 4 and "the querying party" in line 6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claim 1-6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waite et al. (US Pub. No. 2002/0004826) in view of Ozaki et al. (US Pub. No. 2004/0177171).

Regarding **claims 1 and 5**, Waite discloses a method for transmitting a communication from a data transmission network (figure 1 delivering mail server network) to a receiving data transmission network (figure 1 receiving mail server network), where the communication is directed to the transmitting network element (figure 1 receiving mail server 101) in the receiving data transmission network on the basis of this network address (paragraph 37, IP address of receiving mail server), wherein a first connection to the receiving data transmission network is formed for querying the network address of the transmitting element of the receiving data transmission network from the private name server before directing the communication, after which the communication is directed to said network element (figures 2 and 3; paragraph 37; a delivering mail server transmits a request for a receiving mail server's IP address, a dynamic address server via a private name server returns the receiving mail server's IP address to the delivering mail server. The delivering mail server in turn uses the IP address to contact receiving mail server).

Waite does not teach the data transmission networks are two separate networks. However, Ozaki discloses a delivering mail server and receiving mail server are on two separate networks (see figure 1). Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to implement in Waite transmission networks are two separate networks. The motivation is to allow electronic mail communication between two different networks or two different geographic locations.



Regarding **claim 2**, all limitations in claim 1 are disclosed above. Waite further teaches said private domain name server comprises in a centralized manner, in addition to the network address in question, the transmission data of the other network elements of said receiving data transmission network (paragraph 12, the server stores multiple IP addresses and server codes).

Regarding **claim 3**, all limitations in claim 1 are disclosed above. Waite further teaches a query is performed from the local name server of the transmitting data transmission network to the local domain name server of the receiving data transmission network (see figure 1; delivering mail server queries a DNS private name server).

Regarding **claim 4**, all limitations in claim 3 are disclosed above. Waite and Ozaki do not explicitly teach the mail server maintains private name server's addresses in both network. However, Ozaki teaches a DNS server in the same network as delivering mail server (figure 1 organization LAN 90 wherein the DNS server converts domain name to an IP address in paragraph 48). Thus it is implied the delivering mail server maintains the DNS's address (other private name server). Waite further teaches a network address of a private name server is maintained by said local name server (paragraph 37; delivering name server converts receiving mail domain to an IP address of the private name server). Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to implement in Waite and Ozaki private name server's addresses in both networks. The motivation is have access to databases for transmission to other users in another network.

Regarding **claim 6**, all limitations in claim 5 are disclosed above. Waite further teaches the transmitting data transmission network comprises a local name server (delivering mail server) which is arranged to perform a query from said private name server (DNS server) (see figure 1).

**Claim 10** is rejected similarly as claim 1 above.

34. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waite et al. (US Pub. No. 2002/0004826) in view of Ozaki et al. (US Pub. No. 2004/0177171) in view of Callas et al. (US Pub. No. 2004/0133775).

Regarding **claims 7 and 11**, all limitations in claims 5 and 10 are disclosed above. Waite and Ozaki do not teach the private domain name server is a LDAP server. However, Callas discloses an e-mail server contains an LDAP server (paragraph 83). Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to implement in Waite and Ozaki a LDAP server. The motivation is to have an database containing user profiles.

35. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waite et al. (US Pub. No. 2002/0004826) in view of Ozaki et al. (US Pub. No. 2004/0177171) in view of Tuunanen (US Pub. No. 2006/0052087).

Regarding **claim 8**, all limitations in claim 5 are disclosed above. Waite and Ozaki do not teach the data transmission network is an IMS network. However, Tuunanen discloses an IMS network for delivering messages (figure 2 paragraph 27). Therefore it would have been obvious to one with ordinary skill in the art at the time of

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the invention to implement in Waite and Ozaki an IMS network. The motivation is to utilize IMS network capability to deliver messages.

Regarding **claim 9**, all limitations in claim 8 are disclosed above. Tuunanen further teaches an I-CSCF node (figure 2).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TITO PHAM whose telephone number is (571)272-4122. The examiner can normally be reached on Monday-Friday 9AM-6PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Ryman can be reached on 571-272-3152. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Daniel J. Ryman/

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